

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD G. KENNEDY

Appeal 2007-2162
Application 09/474,418
Technology Center 2144

Decided: October 17, 2007

Before JAMES D. THOMAS, KENNETH W. HAIRSTON, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellant invented a system and method for remote servicing of in-field products or equipment at a customer site, such as medical diagnostic equipment, from a centralized on-line service center. Specifically, a portable service interface is interposed between the in-field product and the on-line center. The portable service interface enables the in-field product -- a product that is otherwise incapable of directly communicating with the on-line service center -- to directly communicate with the on-line service center.¹ Claim 1 is illustrative:

1. A remote servicing communication system for in-field product comprising:

at least one on-line center having access to service software at a centralized facility as to service in-field product remotely;

an in-field product at a customer site that is not readily capable of direct communication with the on-line center;

at least one portable service interface operable with the in-field product at the customer site and having software for communication with the on-line center;

a first communications link connecting the portable service interface to the on-line center; and

a second communications link connecting the portable service interface with the in-field product to complete a connection between the in-field product and the on-line center through the portable service interface.

The Examiner relies on the following prior art references to show unpatentability:

¹ See *generally* Specification 3:24 - 4:15.

| | | |
|------|--------------|---------------|
| Wood | US 5,715,823 | Feb. 10, 1998 |
| Friz | US 5,786,994 | Jul. 28, 1998 |
| Jago | US 5,938,607 | Aug. 17, 1999 |

1. Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jago and Wood.²
2. Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jago and Friz.³
3. Claims 1-24 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting⁴ over claims 1-44 of Application Serial No. 09/199,506.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer⁵ for their respective details. In this decision, we have considered only those arguments actually made by

² We note that the Examiner's Answer does not expressly state the Examiner's grounds of rejection with particularity (Answer 3). We therefore presume that the Examiner intended to incorporate the specific grounds of rejection articulated on Pages 2-13 of the Final Rejection in the Answer. We remind the Examiner, however, that such incorporations by reference are improper under current practice. *See* MPEP § 1207.02 ("An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer."). *See also Ex parte Metcalf*, 67 USPQ2d 1633, 1635 n.1 (BPAI 2003).

³ The Examiner's inclusion of Slayton in the statement of the rejection (Final Rejection 10) is presumed to be a typographical error as the rejection is clearly based solely on Jago and Friz.

⁴ Although the Examiner does not indicate the double patenting rejection is obviousness-type double patenting (ODP) (Answer 3; Final Rejection 12-13), the rejection nonetheless is based on ODP.

⁵ We refer to the most recent Answer mailed Nov. 1, 2006 throughout this opinion.

Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

The Obviousness Rejection Based on Jago and Wood

We first consider the Examiner's rejection of claims 1-24 under 35 U.S.C. § 103(a) as unpatentable over Jago in view of Wood. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Discussing the question of obviousness of a patent that claims a combination of known elements, the Court in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.]*, 425 U.S. 273, 189 USPQ 449 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57, 163 USPQ 673 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. Such a showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding the independent claims, the Examiner's rejection essentially finds that Jago teaches every claimed feature except for at least one on-line center having access to service software at a centralized facility so as to service in-field product remotely. The Examiner cites Wood as teaching this feature and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Wood’s teachings of an ultrasound diagnostic imaging system with universal access with Jago

to access ultrasound systems via an open architecture communication network (Final Rejection 2-4).

Appellant argues, among other things, (1) that there is no motivation to combine the references in the manner done by the Examiner, and (2) the prior art does not disclose an in-field product at a customer site that is not readily capable of direct communication with the on-line center as claimed. In this regard, Appellant emphasizes that the system of Wood is readily capable of external connectivity with no hardware requirements. Appellant adds that Jago similarly teaches an in-field product that is readily capable of remote communication to allow remote review of images acquired by the device. As such, Appellant contends, modifying the communicative in-field product of Wood into a system that is incapable of direct communication with a remote facility is contrary to conventional wisdom in the art as evidenced by Jago. In short, Appellant argues that not only do the references teach away from the claimed invention because they are already capable of direct communication, they fail to disclose the claimed limitations (Br. 6-15; Reply Br. 2-4).

The Examiner contends that at the time of the invention, devices did not have built-in connection capability (e.g., modems or Ethernet connectivity) as a standard feature. According to the Examiner, such connectivity was added on to these devices; an added feature which ostensibly implies that the ultrasound systems in Jago were not readily capable of direct connection as claimed (Answer 8).

The key issue before us, then, is relatively narrow: whether the cited prior art reasonably teaches or suggests an in-field product at a customer site

that is not readily capable of direct communication with the on-line center. For the reasons that follow, we answer this question “no.”

Jago discloses an ultrasound imaging system 10 that includes an HTTP server 30. The server not only enables access to images and reports from storage medium 24, but also makes the diagnostic information of the ultrasound system available to other users via a communication network (Jago, col. 3, ll. 19-30; Figs. 1 and 2). Multiple ultrasound systems can be connected to a hub 304 of an Ethernet network 300 which enables the connected ultrasound systems to access images from a reference image library 400 that is also connected to the network (Jago, col. 9, ll. 49-65; Fig. 2).

As Jago clearly shows, the “in-field products” (i.e., the ultrasound systems) are readily capable of direct communication with an on-line center. That is the very essence of Jago: to enable the ultrasound systems to communicate with online entities (i.e., remote users, image libraries, etc.).

Similarly, Wood’s ultrasound system 10 directly communicates with on-line entities via a server (Wood, col. 3, ll. 18-29; Figs. 1-3). Moreover, multiple ultrasound systems can be connected to a hub 240 for access to a centralized server or remote users via a gateway or net/modem 252 (Wood, col. 13, l. 26 – col. 14, l. 28; Figs. 15-17). Such connectivity can facilitate remote software upgrades (Wood, col. 14, ll. 29-36).

The fact that modems or Ethernet connectivity interfaces are utilized (or even added on) to facilitate such communication does not mean that the devices or “in-field products” are somehow incapable of direct communication with the on-line center. To hold otherwise would simply

strain the meaning of “direct communication” and run counter to the clear teachings of the references.

We reach this conclusion even if we construed the recited “portable service interface” as the modem or Ethernet interface in Jago or Wood. To be sure, removing the modems and Ethernet interfaces from the ultrasound systems in Jago or Wood would certainly render them incapable of on-line communication. But not only does such a modification run counter to the references’ teachings, there is simply no reasonable basis on this record to do so. Moreover, even if the modems and Ethernet interfaces were added to the ultrasound systems as the Examiner suggests, the ultrasound systems are nevertheless readily capable of direct communication with the on-line center. To suggest otherwise simply ignores the clear teachings of the references.

For these reasons, we cannot sustain the Examiner’s obviousness rejection of independent claims 1, 10, and 21 over Jago in view of Wood. Moreover, we will not sustain the rejections of dependent claims 2-9, 11-20, and 22-24 for similar reasons.

The Obviousness Rejection Based on Jago and Friz

We will also not sustain the Examiner’s rejection of claims 1-24 under 35 U.S.C. § 103(a) over Jago and Friz. Our previous discussion regarding the deficiencies of Jago applies equally here and we incorporate that discussion by reference. Friz, however, does not cure the deficiencies of Jago with respect to the in-field product being incapable of direct communication with the on-line center as claimed.

Friz discloses a remote performance monitoring system 46 that (1) monitors laser imagers 14₁-14_N located remotely from the system, (2) acquires and stores data corresponding to the respective imager's performance, usage, and logged errors, and (3) generates individual reports 52, 54, and 56 based on this data (Friz, col. 11, l. 3 - col. 12, l. 21; Fig. 3). To this end, the performance monitoring system establishes communication with the appropriate laser imager via modem over a telephone line (Friz, col. 11, ll. 45-47).

Friz therefore teaches that the "in-field products" (laser imagers) are readily capable of direct communication with the remote performance monitoring system via modem. Indeed, direct communication with the laser imagers is the very essence of Friz' invention.

In short, Friz simply does not cure the deficiencies of Jago with respect to providing an in-field product that is incapable of direct communication with the on-line center as claimed. Therefore, we will not sustain the Examiner's rejection of independent claims 1, 10, and 21 based on Jago and Friz. Likewise, we will not sustain the rejection of dependent claims 2-9, 11-20, and 22-24 for similar reasons.

The Provisional Double Patenting Rejection

We will also not sustain the Examiner's provisional rejection of claims 1-24 under the judicially-created doctrine of obviousness-type double patenting (ODP) over claims 1-44 of Application Serial No. 09/199,506. Although the Examiner indicates that the conflicting claims are not identical, they are not patentably distinct from each other because "the context of the claimed invention is the same as the context of the cited claims of the ['506

application].” The Examiner adds that allegedly there is no reason why the claims in the present application could not have been presented in the ‘506 application (Final Rejection 12-13).

We note at the outset that the provisional status of the double patenting rejection is now moot as the ‘506 application has issued as U.S. Patent 7,127,499 B1. Moreover, the Examiner’s ODP rejection does not account for the status of the claims of the ‘506 application at the time the Answer was mailed.⁶

In any event, the Examiner’s ODP rejection also falls well short on the merits as well. The Examiner’s mere assertion in the rejection without any supporting analysis whatsoever hardly provides a reasonable basis for a prima facie case of obviousness-type double patenting. In short, the Examiner did not specifically identify the differences between the claims of the ‘506 application and the claims of the present application, let alone reasonably explain why these perceived differences would have been obvious to one of ordinary skill in the art at the time of the invention.

Furthermore, it is unclear, at best, what the Examiner means by the applications’ claims having the same “context.” Nevertheless, to the extent that the applications’ claims recite inventions with similar “contexts” as the Examiner summarily alleges, this mere observation hardly means that the claims are patentably indistinct.

⁶ The Examiner’s Answer was mailed on Nov. 1, 2006 and rejects the claims of the present appeal based on claims 1-44 of the ‘506 application. However, claims 1-14 and 22-35 of the ‘506 application were cancelled in an amendment after final rejection filed May 5, 2006 which was entered July 5, 2006.

Therefore, we cannot sustain the Examiner's provisional obviousness-type double patenting rejection of claims 1-24. Since the provisional ODP rejection is now moot, and we conclude that the Examiner has failed to establish a prima facie case of obviousness-type double patenting, we need not address the procedural issue noted by Appellant (Br. 22) and the Examiner (Answer 13) regarding withdrawal of the provisional rejection.

Other Issues

Although we do not sustain the Examiner's rejections based on the cited prior art, we emphasize that we are constrained by the record before us. We cannot say that no prior art exists that would teach or suggest the claimed limitations. We can say, however, that no such prior art exists on this record.

In view of the sheer scope and breadth of the claims, the Examiner should consider prior art pertaining to conventional computer systems that utilize remote diagnostics for troubleshooting purposes. In this regard, the Examiner should consider references that involve, among other things, on-line entities that remotely connect to customer computers via a network (or the internet) to communicate with peripherals attached to the customer's computer -- peripherals that are otherwise incapable of directly communicating with the on-line center without the customer's computer.

For example, the Examiner should consider references that teach the concept of a remote help desk (i.e., an "on-line center") that remotely connects to a customer's computer ("portable service interface") to communicate with a peripheral such as a printer ("in-field product") attached to the customer's computer. Through such communication with the

peripheral via the customer's computer, the help desk could then communicate with the peripheral to obtain diagnostic information regarding the peripheral. Significantly, the peripheral would be normally *incapable* of communicating directly with the on-line center (help desk) without the "portable service interface" (customer's computer).

DECISION

We have not sustained the Examiner's rejections with respect to any claims on appeal. Therefore, the Examiner's decision rejecting claims 1-24 is reversed.

Appeal 2007-2162
Application 09/474,418

REVERSED

eld

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC
136 SOUTH WISCONSIN STREET
PORT WASHINGTON, WI 53074